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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Gebhard APPEAL NO.: 2004-1187
SERIAL NO.: 09/328,749 GROUP NO.: 3728
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SUPPLEMENTAL REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 1.193

This Supplemental Reply Brief is submitted in response to the Primary Examiner's Supplemental Answer mailed August 9, 2004, for which the period of response expires on Tuesday, October 12, 2004, under 37 C.F.R. § 1.7(a).

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INTRODUCTION

The following is submitted in reply to the Primary Examiner's Supplemental Answer of August 9, 2004, subsequent to the Remand from the Board of Patent Appeals and Interferences ("BPAI"). This Supplemental Reply Brief addresses each argument set forth in the Supplemental Answer. For consistency, Appellant retains the lettering-numbering scheme used in the Appeal Brief, Examiner's Answer, Reply Brief, and Examiner's Supplemental Answer for identifying the arguments. Appellant relies on arguments set forth in the Appeal Brief and Reply Brief to the extent the Examiner does not offer further arguments in the Supplemental Answer.

As an initial matter, the Supplemental Answer appears to include inconsistencies and errors, rendering portions of it unclear. For example, on page five, section I-B-11 is titled "[r]esponse to: The cited references, alone or in proper combination, do not render claims 16, 17 and 19 unpatentable under 35 U.S.C. § 103(a)." (Emphasis added.) The Examiner's associated argument is irrelevant to claims 16, 17, and 19, but instead appears to relate to claim 20. Since Appellant and the Examiner have stated their adherence to the original lettering-numbering scheme for the arguments, and since section I-B-11 in Appellant's previous briefs and the Examiner's initial answer relates to claim 20, Appellant assumes that the Examiner used the incorrect heading for this section of the Supplemental Answer. Consequently, Appellant's discussion below reflects the assumption that section I-B-11 in the Supplemental Answer refers to claim 20, not claims 16, 17, and 19, as titled.

Similarly, on page seven of the Supplemental Answer, section III-A-1 is titled "[r]esponse to: The cited reference[s], alone or in proper combination, do not render claims 1-4, 11-14 and 18 unpatentable under 35 U.S.C. § 103(a)." (Emphasis added.) The Examiner's associated argument appears to relate to claims 2-4, which is consistent with the title of section III-A-1 in Appellant's previous briefs and the Examiner's initial answer. Appellant assumes that the Examiner used the incorrect heading for this section of the Supplemental Answer, and Appellant's discussion below reflects the assumption that section III-A-1 in the Supplemental Answer refers to claims 2-4, not all of claims 1-4, 11-14, and 18, as titled.

On page four of the Supplemental Answer, the Examiner follows the title of section I-B-7 with the parenthetical phrase "[t]his also applies to sections 8-13 in the Reply Brief" (emphasis

added). Following section 7 are sections 11-13, each reciting or referencing other arguments. Supplemental Answer, pp. 5-6. Given this overlap of section numbers, it is unclear whether (i) the above-referenced parenthetical phrase is erroneous and should have referred to sections 8-10, or (ii) the Examiner's arguments in sections 11-13 incorporate the argument from section 7. In case (i), the Examiner's argument in section 7 does not supplement the argument in sections 11-13. Appellant's discussion below reflects the assumption embodied in case (ii): that Examiner's arguments in sections 11-13 incorporate the argument from section 7 of the Supplemental Answer.

ARGUMENT

I. Claims 1, 8-11, 15-17, 19-21, 24, and 26 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631) in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820).

B. The cited references, alone or in proper combination, do not render claims 1, 8-11, 15-17, 19-21, 24, and 26 obvious and unpatentable under 35 U.S.C. § 103(a).

1. U.S. Patent No. 4,922,631 to Anderié (issued May 8, 1990).

In its Remand to the Examiner, the BPAI solicited the Examiner's position on "whether or not the entirety of the intermediate sole member (e.g., 101) in Anderié '631 can be considered to be a 'torsion system' like that defined in appellant's claims 1 and 26" and thereby anticipate these claims. Remand, p. 3. The Examiner apparently does not agree that this interpretation of Anderié would anticipate claims 1 and 26 and states:

[T]here would be no sole that would be separate from the torsion system, i.e. the torsion system and the sole would be one in the same. The claims clearly call for "a torsion system for a cycling shoe including a sole with a forefoot area and a rearfoot area, the torsion system including ...". This places the sole on the shoe and the torsion system being separate from the sole.

Supplemental Answer, p. 2.

Appellant agrees with the Examiner on this point. Because the claimed torsion system is distinct from the sole, Anderié does not anticipate claims 1 and 26.

The Examiner has taken the position that the Anderié limb portions 114, 115, 116, as shown in Anderié Figure 6, project beyond the “adjacent valleys between each rib (section 113).” Supplemental Answer, p. 3. The Examiner apparently has concluded that these “valleys” define one or more surfaces that the ribs (i.e., limb portions 114, 115, 116) project beyond. Appellant respectfully disagrees with this interpretation of the Anderié reference.

The “surface” of an object is, according to the plain meaning of the term, “the outer or the topmost boundary of an object.” *The American Heritage Dictionary of the English Language* (4th ed. 2000). Consistent with this definition, and as discussed in the Reply Brief, the “surface” of the Anderié elongate bar 110 is defined by the rectangular outline of Figure 6. The “valleys” and other structures to which the Examiner refers are inside this rectangular outline and are therefore internal to the elongate bar 110. Consequently, these features (e.g., the “valleys”) cannot define a “surface” because they are not part of the outer or the topmost boundary of the elongate bar 110.

Appellant’s independent claims 1, 21, and 26 include the limitation that a rib project “beyond an adjacent surface.” Applying the plain meaning of the term “surface,” it is clear that the claims require that the rib project beyond the outer or the topmost boundary. Appellant respectfully submits that Anderié neither teaches nor suggests this feature.

4. The cited references, alone or in proper combination, do not render claim 1 unpatentable under 35 U.S.C. § 103(a).

The Examiner, for the first time, now expresses in the Supplemental Answer the view that Dubner discloses two envelopes: “envelope 25” and “second envelope 26.” Supplemental Answer, p. 3. The Examiner states that “the second envelope [26] ... does not extend to the forefoot area, not envelope 25 which is shown in Figure 1.” *Id.* Appellant is unclear as to the Examiner’s description of these features in Dubner. It appears that the Examiner is contending that “envelope 26” does not extend to the forefoot area, but “envelope 25” does.

Dubner refers to the structure denoted by reference designator 25 as a “supportive envelope element,” not an envelope. Dubner, col. 5, l. 29. Although Dubner also uses reference designator 25 to refer to a staple (col. 5, l. 24; Figures 1, 2), and also identifies the supportive envelope element using reference designator 13 (col. 4, ll. 67-68), Dubner clearly discloses that

the supportive envelope element is not another envelope in addition to envelope 26. Instead, Dubner discloses that the supportive envelope element 25 is an assembly of components that includes at least the cushion 27A and the envelope 26, folded and sealed in a specific manner. Col. 5, ll. 29-48.

Contrary to the Examiner's assertion, there is no "envelope 25" shown in Dubner Figure 1. Rather, Figure 1 depicts the staple 25. It is Figure 5, for example, that illustrates the supportive envelope element 25 and envelope 26, and shows that these features are coextensive. Dubner expressly discloses that envelope 26 terminates at "the general area of the ball of the foot" and not "under it." Col. 5, l. 5; col. 6, ll. 29-30, 43-45; col. 7, l. 42 – col. 8, l. 1. Because the supportive envelope element 25 is coextensive with the envelope 26, the supportive envelope element 25 must also terminate at the general area of the ball of the foot and not under it. This is illustrated further by comparing the location of the semi-flexible plastic piece 44 shown in Figures 5, 10, and 11. Figure 5 clearly shows that the semi-flexible plastic piece 44 is located at the forward extent of the supportive envelope element 25 and the coextensive envelope 26. Figures 10 and 11 show that the semi-flexible plastic piece 44 is proximate the general area of the ball of the foot, but not under it. Consequently, Figures 10 and 11 show that the supportive envelope element 25 and the coextensive envelope 26 terminate in the same location, because their forward extents are coincident with the semi-flexible plastic piece 44.

The Examiner states that the "ball area of the foot denounces [sic] where the toe area begins." Supplemental Answer, p. 3. Appellant assumes that the Examiner is contending that the "ball area" of the foot indicates where the toe area begins. It is clear from Dubner that the supportive envelope element 25 and the coextensive envelope 26, while terminating in the general area of the ball of the foot, terminate rearward and not under the ball area. Figures 10, 11; col. 5, ll. 43-45. This is well to the rear of the toe area (i.e., where the toes and toe bones (phalanges) are located). Accordingly, Dubner does not teach and, in actuality, teaches away from, extension of a supportive innersole so as to span substantially the entire forefoot area, from the midtarsal area to the toe area.

As discussed in the Appeal Brief and the Reply Brief, the Examiner's combination of the Anderié, Dubner, and Kraeuter et al. references is improper and does not support a prima facie case of obviousness. The Examiner's rationale for the combination fails to consider how the

references teach away from each other with respect to, for example, flexibility of a shoe. Consequently, a rejection under 35 U.S.C. § 103(a) cannot be maintained. *In re Rudko*, Civ. App. No. 98-1505, slip op. at 5-6 (Fed. Cir. May 14, 1999). Further, the Examiner fails to appreciate that prior art references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention – one cannot pick and choose among individual parts of assorted prior art references “as a mosaic to recreate a facsimile of the claimed invention.” *Akzo N.V. v. United States Int’l Trade Comm’n*, 1 U.S.P.Q.2d (BNA) 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). The Examiner’s statement “[w]hether the support is flexible or not”¹ illustrates that the Examiner is ignoring at least this attribute of Dubner, an attribute that is incompatible with the other cited references (i.e., Anderié and Kraeuter et al.).

As stated in the Reply Brief, the Examiner’s combination of the cited references runs afoul of the rules of *In re Rudko* and *Akzo N.V.* and clearly demonstrates that the Examiner has engaged in impermissible hindsight reconstruction. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1600 (Fed. Cir. 1988)). With respect to this issue as it applies to the instant ground of rejection of claim 1, the Examiner, in the Supplemental Answer, has failed to rebut Appellant’s argument set forth in the Reply Brief and refers to “what was already discussed in the Examiner’s Answer.” Supplemental Answer, p. 3. Nevertheless, there is no discussion of this issue in the corresponding section of the Examiner’s Answer. Examiner’s Answer, pp. 10-11.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 1 in view of the Anderié, Dubner, and Kraeuter et al. references.

¹ Supplemental Answer, p. 3.

5. The cited references, alone or in proper combination, do not render claim 8 unpatentable under 35 U.S.C. § 103(a).

As stated in the Appeal Brief, Appellant respectfully submits that the Anderié, Dubner, and Kraeuter et al. references cannot be combined properly to render claim 8 obvious because the various openings and holes disclosed in the references address different problems. Appeal Brief, pp. 15-16. An invention is nonobvious if the elements in the reference deal with problems different than those addressed by the claimed invention. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. (BNA) 481, 488-89 (Fed. Cir. 1984). Further, claim 8 depends from claim 1 and includes the limitations thereof and, as discussed above, the combination of Anderié, Dubner, and Kraeuter et al. fails to render claim 1 obvious. The additional limitation in claim 8 further distinguishes Appellant's claimed invention over these references.

In the Supplemental Answer, the Examiner continues to argue that the "area between the [Anderié] bar extensions" is Appellant's claimed aperture. Supplemental Answer, p. 4. As stated in the Reply Brief, the areas between the Anderié limb portions 114, 115, 116 (referred to as "valleys" or "section 113" elsewhere in the Supplemental Answer) are internal to the elongate bar 110. In other words, these valleys do not interrupt the surface of the elongate bar 110 and, therefore, cannot be considered apertures. The plain meaning of "aperture" is "hole." *The American Heritage Dictionary of the English Language* (4th ed. 2000). There can be no aperture or hole when the surface is uninterrupted. The Examiner also distinguishes Appellant's use of the term "holes" from "apertures." Supplemental Answer, p. 4. This distinction is misplaced, since Appellant used the term "hole" to clarify the definition of the term "aperture," by highlighting the plain meaning of the latter.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 8 in view of the Anderié, Dubner, and Kraeuter et al. references. With respect to instant ground of rejection of claim 8, the Supplemental Answer, like the previous Examiner's Answer, fails to justify that the combination of these references supports this rejection. The Examiner's arguments are directed toward the Anderié reference alone and are therefore insufficient to support the rejection of record under 35 U.S.C. § 103(a).

6. The cited references, alone or in proper combination, do not render claim 9 unpatentable under 35 U.S.C. § 103(a).

Appellant's claim 9 stands rejected in view of the combination of the Anderié, Dubner, and Kraeuter et al. references. As stated in the Appeal Brief, Appellant argues that these references teach away from each other with respect to Appellant's single plate limitation and, therefore, claim 9 is nonobvious.

In response to Appellant's Reply Brief, the Examiner contends that "[n]owhere does the examiner state anything about Anderié alone on page 12 of the Examiner's answer." Supplemental Answer, p. 4. Appellant respectfully disagrees. In rebutting the argument that Appellant advanced in the Appeal Brief, the Examiner refers to "stiffening elements," which are associated with the Anderié reference alone, and does not refer to any of the features in the other references (Dubner and Kraeuter et al.) used to support the rejection of claim 9. Examiner's Answer, p. 12. Accordingly, by not implicating Dubner and Kraeuter et al., the Examiner's rebuttal fails to justify that the combination of references supports the rejection of record. Reply Brief, p. 7. Further, Anderié alone cannot support the rejection of claim 9, because it (i) does not alone support the rejection of claim 1, from which claim 9 depends, and (ii) discloses stiffening elements 9, 109 that include at least three separate components, thereby teaching away from Appellant's single plate limitation.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 9 in view of the Anderié, Dubner, and Kraeuter et al. references.

7. The cited references, alone or in proper combination, do not render claim 10 unpatentable under 35 U.S.C. § 103(a).

8. The cited references, alone or in proper combination, do not render claim 11 unpatentable under 35 U.S.C. § 103(a).

9. The cited references, alone or in proper combination, do not render claim 15 unpatentable under 35 U.S.C. § 103(a).

10. The cited references, alone or in proper combination, do not render claims 16, 17, and 19 unpatentable under 35 U.S.C. § 103(a).

The Examiner responds to at least sections I-B-7 through I-B-10² of the Reply Brief in one paragraph. Supplemental Answer, pp. 4-5. Consequently, Appellant discusses these four sections, with the headings appearing directly above, concurrently as follows.

The prosecution record is clear that claims 10, 11, 15-17, and 19 stand rejected as unpatentable over the combination of Anderié, Dubner, and Kraeuter et al. *See, e.g.*, Office Action, Jan. 24, 2003, p. 2. The Examiner argues that Dubner and Kraeuter et al. teach features present in claim 1. To the extent these features are present in claim 1, they are also present in claims 10, 11, 15-17, and 19 because of claim dependencies. Nevertheless, in the Examiner's Answer, the Examiner limited the rebuttals to Appellant's arguments by discussing only the Anderié reference. In the Reply Brief, Appellant stated that these limited rebuttals were insufficient to justify that the combination of the references supported the rejection. In response, the Examiner fails to address the combination of the references and states, with respect to at least sections 7-10, that Anderié "teaches the added limitations [of claims 10, 11, 15-17, and 19], and that the other references are not needed to teach this [sic] limitation[s]." Supplemental Answer, pp. 4-5.

The Examiner bears the statutory duty of supplying a factual basis supporting a rejection. 35 U.S.C. § 132. Appellant assumes that the Examiner has not changed the basis of the rejection of claims 10, 11, 15-17, and 19 to one requiring only the Anderié reference. Consequently, by failing to address how the combination of Anderié, Dubner, and Kraeuter et al. allegedly renders

² As discussed in the Introduction, Appellant is proceeding under the assumption that the Examiner is advancing the argument in section I-B-7 in sections I-B-11 through I-B-13 as well.

claims 10, 11, 15-17, and 19 obvious, the Examiner has not satisfied the statutory requirement, and Appellant respectfully submits that the rejection cannot be maintained.

Further, and as stated in the Appeal Brief and Reply Brief, the Anderié, Dubner, and Kraeuter et al. references teach away from each other with respect to the limitations in claims 10, 11, 15-17, and 19. Consequently, Appellant respectfully submits that these claims are nonobvious in view of these references. As previously discussed, the combination of these references also fails to show or suggest at least the limitations of claim 1 and the additional limitations in claims 10, 11, 15-17, and 19. Accordingly, a prima facie case of obviousness has not been established with respect to these claims. *See, e.g., In re Wright*, 6 U.S.P.Q.2d (BNA) 1959, 1962 (Fed. Cir. 1988), *overruled in part by In re Dillon*, 16 U.S.P.Q.2d (BNA) 1897 (Fed. Cir. 1990), *and cert. denied*, 500 U.S. 904 (1991); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987).

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claims 10, 11, 15-17, and 19 in view of the Anderié, Dubner, and Kraeuter et al. references.

11. The cited references, alone or in proper combination, do not render claim 20 unpatentable under 35 U.S.C. § 103(a).

As described in the Introduction, Appellant's discussion below responds to the Examiner's argument set forth in section I-B-11 of the Examiner's Supplemental Answer, notwithstanding the apparent typographical error in the title of that section referring to the claim at issue.

As discussed in the Appeal Brief and the Reply Brief, Anderié discloses the use of materials with different hardness in the stiffening element 109 and anchoring inserts 118, 119 above and below a plane P-P. In other words, those portions of the stiffening element 109 and anchoring inserts 118, 119 above the plane P-P may have one hardness, and the remaining portions below the plane P-P may have a different hardness. Consequently, Appellant respectfully disagrees with the Examiner's assertion that "[w]hether these portions are above or below the line P-P is irrelevant." Supplemental Answer, p. 5 (emphasis added). P-P defines a plane, not a line. This plane helps describe a composite structure that exhibits a hardness

variation from top to bottom (i.e., above and below the plane P-P), but has the same material properties front to back, that is, in the forefoot, rearfoot, and intermediate portions.

The Examiner states that “appellant is arguing the intermediate portion being along the center line of the sole which is contrary to how the intermediate portion was defined in claim 1.” *Id.* Appellant respectfully disagrees. Appellant does not refer to a “center line,” but to a plane P-P as shown in Anderié Figure 5 and described at col. 8, ll. 29-41. Appellant does not rely on this plane P-P to define an intermediate portion. Instead, Appellant describes how Anderié uses the plane P-P to denote the boundary between materials with different hardness. This boundary traverses anchoring insert 118, stiffening element 109, and anchoring insert 119, which the Examiner refers to as the “front portion,” “intermediate portion,” and “rear portion,” respectively. *Id.* Consequently, the hardness of the “front portion,” although it may vary from top to bottom, is no different than the hardness of the “intermediate portion” or “rear portion” as the Examiner uses these terms.

As discussed in the Reply Brief, the Examiner has failed to argue that the combination of the Anderié, Dubner, and Kraeuter et al. references support the instant rejection. To the extent the Examiner is advancing the argument in section I-B-7 of the Supplemental Answer in this section as well³, Appellant incorporates the discussion in section I-B-7 above in this argument for patentability of claim 20.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 20 in view of the Anderié, Dubner, and Kraeuter et al. references.

12. The cited references, alone or in proper combination, do not render claim 21 unpatentable under 35 U.S.C. § 103(a).

The Examiner states “the term ‘for a cycling shoe’ is an intended use statement” Supplemental Answer, p. 5. Appellant is uncertain as to the Examiner’s reason for highlighting this phrase, because this phrase does not appear anywhere in claim 21. Rather, Appellant expressly claims a cycling shoe and recites the various features thereof. Appellant’s Specification discusses the hazards (e.g., knee looping) prevalent in cycling and how they are

³ See discussion *supra* Introduction.

addressed by a cycling shoe that includes a torsion system. *See, e.g.,* Specification, p. 2⁴. Consequently, the term “[a] cycling shoe” in claim 21 gives meaning to the claim and properly defines the invention, so this term must be given patentable weight. *Perkin Elmer Corp. v. Computervision Corp.*, 221 U.S.P.Q. (BNA) 669, 675-76 (Fed. Cir. 1984).

As stated in the Appeal Brief, none of the cited references teach or disclose a cycling shoe. The Examiner’s statement that the “cited art can be used to pedal a bicycle” (Supplemental Answer, p. 5) suggests that the Examiner still fails to appreciate the unique requirements of the claimed cycling shoe as discussed in the Reply Brief. Further, as discussed in the Reply Brief, the Examiner has failed to argue that the combination of the Anderié, Dubner, and Kraeuter et al. references support the instant rejection. To the extent the Examiner is advancing the argument in section I-B-7 of the Supplemental Answer in this section as well, Appellant incorporates the discussion in section I-B-7 above in this argument for patentability of claim 21.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 21 in view of the Anderié, Dubner, and Kraeuter et al. references.

13. The cited references, alone or in proper combination, do not render claim 24 unpatentable under 35 U.S.C. § 103(a).

14. The cited references, alone or in proper combination, do not render claim 26 unpatentable under 35 U.S.C. § 103(a).

With respect to sections I-B-13 and I-B-14 of the Reply Brief, the Examiner does not offer any further argument. Supplemental Answer, p. 6. Consequently, Appellant relies on the arguments presented in the Appeal Brief and Reply Brief on these issues. To the extent the Examiner is advancing the argument in section I-B-7 of the Supplemental Answer in section 13 as well, Appellant incorporates the discussion in section I-B-7 above in this argument for patentability of claim 24.

⁴ Citations to page and line numbers refer to the Specification as filed.

II. Claims 23 and 25 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631) in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820), in further view of Nagano et al. (U.S. Patent No. 5,446,977).

A. The cited references, alone or in proper combination, do not render claims 23 and 25 obvious and unpatentable under 35 U.S.C. § 103(a).

2. The cited references, alone or in proper combination, do not render claims 23 and 25 unpatentable under 35 U.S.C. § 103(a).

The Examiner continues to argue that isolated elements in the cited references, when combined, render Appellant's claims 23 and 24 obvious. Supplemental Answer, pp. 6-7. As discussed in the Reply Brief, it is improper to pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention." *Akzo N.V.* U.S.P.Q.2d (BNA) at 1246. Accordingly, Appellant respectfully submits that the Examiner has engaged in improper hindsight reconstruction, piecing together Appellant's invention using the claims as a guide. As a result, the instant rejection of claims 23 and 25 is improper and cannot be maintained.

Appellant also argued in the Appeal Brief that several of the cited references teach away from each other, thereby failing to render the claimed invention obvious. For example, Appellant discussed (i) how the Nagano et al., Anderié, and Dubner references teach away from Kraeuter et al. with respect to bending-flexing attributes, and (ii) how Nagano et al. teaches away from Dubner, because a combination of these references would produce a nonfunctional device. The Examiner responded to the first point by reiterating the argument in the Examiner's Answer, and did not respond to the second point. Supplemental Answer, pp. 6-7.

As discussed above, the Examiner bears the statutory duty of supplying a factual basis supporting a rejection. 35 U.S.C. § 132. The Examiner still fails to address how the combination of cited references allegedly renders claims 23 and 25 obvious. For the first time, the Examiner refers to a "shortcut explanation" to justify the instant rejection. Appellant respectfully submits that this cursory treatment, particularly in the present appellate context, falls far short of satisfying the statutory requirement. Consequently, the rejection cannot be maintained.

In view of the above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claims 23 and 25 in view of the Anderié, Dubner, Krauter et al., and Nagano et al. references.

III. Claims 2-4, 11-14, and 18 constitute nonobvious subject matter and are patentable over Anderié (U.S. Patent No. 4,922,631), in view of Dubner (U.S. Patent No. 3,903,621) and Krauter et al. (U.S. Patent No. 5,915,820).

A. The cited references, alone or in proper combination, do not render claims 2-4, 11-14, and 18 obvious and unpatentable under 35 U.S.C. § 103(a).

1. The cited references, alone or in proper combination, do not render claims 2-4 unpatentable under 35 U.S.C. § 103(a).

As described in the Introduction, Appellant's discussion below responds to the Examiner's argument set forth in section III-A-1 of the Examiner's Supplemental Answer, notwithstanding the apparent typographical error in the title of that section referring to the claims at issue.

The Examiner states that "appellant's arguments that there are other factors that influence the angle of rotation in addition to the 'torsional loads' ... is not clearly understood." Supplemental Answer, p. 7. Appellant provided the corresponding information in the Reply Brief, as background, to convey the complexity of the claimed invention. As stated in the Reply Brief, Appellant argues that the references cannot be combined properly to render claims 2-4 obvious because the references (i) do not teach or suggest an angular range for twisting, (ii) teach away from allowing torsional rotation (i.e., twisting), and (iii) teach non-torsional flexing. Further, as stated in the Appeal Brief, the Examiner's "testing and optimization" basis for the instant ground of rejection of claims 2-4 is flawed, because the references fail to teach or suggest optimization of torsional rotation as a function of torsional load. *In re Antonie*, 195 U.S.P.Q. (BNA) 6, 8 (C.C.P.A. 1977).

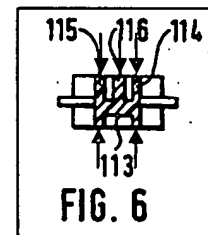
The Examiner has neither rebutted these arguments, nor offered any additional argument in response to section III-A-1 of the Reply Brief. Supplemental Answer, p. 6. Consequently, Appellant relies on the arguments presented in the Appeal Brief and Reply Brief on this issue. In

view of this and the discussion above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claims 2-4 in view of the Anderié, Dubner, and Kraeuter et al. references.

2. The cited references, alone or in proper combination, do not render claims 11-14 unpatentable under 35 U.S.C. § 103(a).

With respect to claims 11-13, the Examiner continues to argue that Anderié “teaches a thickness that falls within the range claimed by the appellant.” Supplemental Answer, p. 7. Other than a general reference to the “above” part of the Supplemental Answer⁵, the Examiner does not address Appellant’s argument set forth in the Appeal Brief and Reply Brief as to the impropriety of combining the cited references with respect to thickness (e.g., constrained versus unconstrained thickness). Consequently, Appellant relies on the arguments presented in the Appeal Brief and Reply Brief on this issue.

The Examiner states that “Figure 6 is a cross-section of Figure 8 and clearly shows the thickness of the intermediate portion being less than the front and rear portions.” *Id.* (Emphasis added). Appellant respectfully disagrees and, as stated in the Reply Brief, submits that the Examiner has adopted contradictory positions as to what the outer rectangle of Anderié Figure 6 represents. Initially, in connection with claim 1, the Examiner asserted that the outer rectangle corresponds to the anchoring insert 119. Examiner’s Answer, p. 9. The intermediate portion of the elongate bar 110 intersects the outer rectangle as shown by the arrow annotations in the excerpt of Figure 6, at right. Consequently, by applying the Examiner’s initial interpretation of Figure 6, it is clear from the annotated intersections that the intermediate portion is at least as thick as the anchoring insert 119. The thickness of the Anderié intermediate portion, therefore, cannot be less than that of the front and rear portions, as the Examiner asserts. The Examiner cannot have it both ways by now contending that, for claim 14, the outer rectangle represents something other than the anchoring insert 119 – something that is thicker than the intermediate portion.



⁵ Supplemental Answer, p. 7.

The Examiner further states that “Figures 1 and 8 ... clearly show the ‘thickness’ of 111, 112 and 118, 119 being thicker, i.e. wider in the Figure, than that of the intermediate section as required by the claim.” Supplemental Answer, p. 7. As an initial matter, Appellant is unclear as to the reference to Figure 1, because none of the elements the Examiner cites appear in that figure. Appellant assumes that the Examiner intended to refer to Figure 4 instead of Figure 1, since the former depicts the end portions 111, 112. Further, and as discussed in the Reply Brief, the Examiner is misinterpreting the “width” of the Anderié structures as Appellant’s claimed thickness. The plain meaning of the term “thickness” is “the dimension between two surfaces of an object, usually the dimension of smallest measure.” *The American Heritage Dictionary of the English Language* (4th ed. 2000). This meaning is consistent with Appellant’s use of the term in the Specification: “[t]hinning the intermediate portion consists of reducing the vertical dimension or thickness of the intermediate portion with respect to the forefoot and rearfoot portions.” Specification, p. 3, ll. 16-17 (emphasis added). Appellant’s claimed thickness relates to the vertical dimension, not the “width” to which the Examiner refers. Consequently, Anderié fails to teach or suggest the features that the Examiner relies on to support the instant rejection.

In view of this and the discussion above, and as stated in the Appeal Brief and Reply Brief, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claims 11-14 in view of the Anderié, Dubner, and Kraeuter et al. references.

3. The cited references, alone or in proper combination, do not render claim 18 unpatentable under 35 U.S.C. § 103(a).

With respect to section III-A-3 of the Reply Brief, the Examiner does not offer any further argument. Supplemental Answer, pp. 7-8. Consequently, Appellant relies on the arguments presented in the Appeal Brief and Reply Brief on this issue.

IV. Claim 7 constitutes nonobvious subject matter and is patentable over Anderié (U.S. Patent No. 4,922,631), in view of Dubner (U.S. Patent No. 3,903,621) and Krauter et al. (U.S. Patent No. 5,915,820), in further view of Eisenbach et al. (U.S. Patent No. 4,815,222).

A. The cited references, alone or in proper combination, do not render claim 7 obvious and unpatentable under 35 U.S.C. § 103(a).

2. The cited references, alone or in proper combination, do not render claim 7 unpatentable under 35 U.S.C. § 103(a).

With respect to section IV-A-2 of the Reply Brief, the Examiner refers to other discussion in the Supplemental Answer, and does not offer any further argument. Supplemental Answer, p. 8. Consequently, Appellant relies on the arguments presented in the Appeal Brief and Reply Brief on this issue.

CONCLUSION

Appellant argues in the Appeal Brief, Reply Brief, and in this Supplemental Reply Brief, that the Examiner has mischaracterized prior art references and has failed to provide adequate justification for the modification or combination of references used to support rejections under 35 U.S.C. § 103(a). For example, with respect to the latter, Appellant has noted that the Examiner fails to consider each reference as a whole. The Examiner's statement that he "clearly has shown what each reference teaches, although not everything that each reference teaches"⁶ is evidence of this deficiency. By not considering "everything that each reference teaches," the Examiner ignored aspects of the references that clearly teach away from each other, the claimed invention, or both. The Examiner also asserts to have clearly shown "the reasoning behind the combination of each reference." Supplemental Answer, p. 8. Appellant respectfully disagrees, because the Examiner's "reasoning" does not address the incompatible attributes and contrary objectives of the references. Unfortunately, the Examiner failed to provide a substantive rebuttal of Appellant's arguments on this issue, generally prefacing any discussion thereof by expressing a lack of understanding of Appellant's argument.

The Examiner's reliance on *In re McLaughlin*, 170 U.S.P.Q. (BNA) 209 (C.C.P.A. 1971) is instructive, because the Examiner recognizes that hindsight reconstruction is improper if it "include[s] knowledge gleaned only from the applicant's disclosure." Supplemental Answer, p. 8. As discussed above and in the Reply Brief, Appellant respectfully submits that the Examiner has engaged in improper hindsight reconstruction by repeatedly isolating parts of the cited references and piecing together Appellant's invention using the claims as a guide. The Examiner's admission that he does not show "everything that each reference teaches"⁷ further demonstrates the Examiner's impermissible methodology. As stated in the Reply Brief, it is undisputed that prior art references must be read as a whole. *See, e.g., Akzo N.V.*, 1 U.S.P.Q.2d at 1246, *In re McLaughlin*, 170 U.S.P.Q. at 212. It is clear from the record that the Examiner has failed to abide by this fundamental rule.

In view of the discussion above, in the Appeal Brief, and in the Reply brief, Appellant respectfully submits that claims 1-4, 7-21, and 23-26 are patentable in view of the cited

⁶ Supplemental Answer, p. 8 (emphasis added).

⁷ *Id.*

references. Appellant urges the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of these claims.

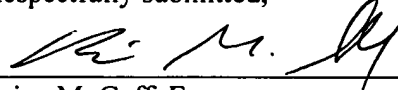
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AF 133

Attorney Docket No. ADI-005
(257/10)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Gebhard
SERIAL NO.: 09/328,749 GROUP NO.: 3728
FILING DATE: 9-Jun-99 EXAMINER: Anthony D. Stashick
TITLE: *Torsion System for an Article of Footwear*

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence, and any documents referred to as enclosed herein, are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to **Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450** on this 12th day of October, 2004.

Monika A. Pychynska
Monika A. Pychynska

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

Submitted are the following:

- (1) Transmittal Form (1 pg.);
- (2) Supplemental Reply Brief (20 pgs.; in triplicate); and
- (3) a return receipt postcard.

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TRANSMITTAL FORM

Application Serial Number	09/328,749
Filing Date	9-Jun-99
First Named Inventor	Gebhard
Group Art Unit	3728
Examiner Name	Anthony D. Stashick
Attorney Docket No.	ADI-005
Patent No.	Not applicable
Issue Date	Not applicable

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Check Attached <input type="checkbox"/> Copy of Fee Transmittal Form	<input type="checkbox"/> Copy of Notice to File Missing Parts of Application <input type="checkbox"/> Formal Drawing(s)	<input type="checkbox"/> Notice of Appeal to Board of Patent Appeals and Interferences <input checked="" type="checkbox"/> Supplemental Reply Brief (in triplicate)
<input type="checkbox"/> Amendment/Response <input type="checkbox"/> Preliminary <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Letter to Official Draftsperson including Drawings [Total Sheets ____]	<input type="checkbox"/> Request For Continued Examination (RCE) Transmittal <input type="checkbox"/> Power of Attorney (Revocation of Prior Powers) <input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Status Inquiry <input checked="" type="checkbox"/> Return Receipt Postcard <input checked="" type="checkbox"/> Certificate of First Class Mailing under 37 C.F.R. 1.8 <input type="checkbox"/> Certificate of Facsimile Transmission under 37 C.F.R. 1.8
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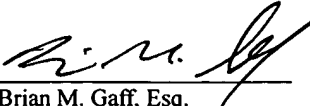
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